

### **REMARKS/ARGUMENTS**

The non-final Office Action of March 24, 2003, has been carefully reviewed and these remarks are responsive thereto. Reconsideration and allowance of the instant application are respectfully requested. Claims 1, 10, 16, and 18 have been amended. Claims 21-29 have been added. Claims 1-29 remain pending.

In the specification, the paragraph beginning at page 11, line 18 has been amended to correct minor editorial errors. These amendments to the specification clearly do not add new matter.

Claim 18 has been amended to correct a minor editorial problem. This amendment does not add new matter. Claims 1, 10, and 16 have been amended to further clarify the claims. These amendments do not add new matter. Claims 21-29 have been added. These new claims are fully supported by Applicants' written description and drawings and clearly do not add new matter.

### **Rejections under 35 U.S.C. § 103(a)**

Claims 1-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cassorla et al. (U.S. Patent No. 5,146,552, hereinafter referred to as *Cassorla*) in view of Admitted Prior Art (APA). Applicants respectfully traverse this rejection.

The Action alleges that *Cassorla* describes every feature of Applicants' independent claim 1, except for the step of, "displaying a page of the electronic document on a computer display device using a document browser that permits a user to move forward and backward among a plurality of document pages." (Action – pages 3 and 4). To overcome the deficiencies of *Cassorla*, the Action relies on page 1, lines 17-22 of Applicants' written description.

The cited portion of Applicants' written description describes typical functions of web browsers. Even assuming, but not admitting, that the cited portion of Applicants' written description describes the displaying step of Applicants' claim 1, and even further assuming, but not admitting, that *Cassorla* describes the other features of Applicants' claim 1 as alleged by the Action, the combination of *Cassorla* and Applicants' written description is improper.

*Cassorla* is a “method for associating annotation with electronically published material.” (Title). *Cassorla* associates annotations to particular areas within a formatted text stream. *Cassorla* requires that the text of a document be “formatted” into an overall organization for headings and ordered paragraphs. (See Col. 6, lines 42-50). As shown in Figures 1 and 2 of *Cassorla* in particular, neither the formatted text stream 25, nor displayed image 25’ is an actual page of the electronic document. “The formatted text stream 25 illustrated in FIG. 2 has structured document tags similar to those referenced above.” (Col. 6, lines 14-16). *Cassorla*’s formatted text stream 25 is an electronic document that has been configured with tags to associate a coordinate system of annotations to the formatted text stream 25. Because Applicants’ invention allows for the display of annotations as superimposed over an actual page of an electronic document, there is no need to pre-format a page in order to display a formatted text stream 25 as an image 25’.

*Cassorla* cannot be properly combined with the cited portion of Applicants’ written description as *Cassorla* requires a formatted text stream 25 in order to operate. *Cassorla* must establish a structure relationship between the original text, the formatted text stream 25, and the associated annotation strings 24. Only after the structure of the formatted text stream 25 is established with an overall organization for headings and ordered paragraphs can annotations be associated with a particular paragraph in accordance with the invention of *Cassorla*. (Col. 6, lines 10-50). Further, *Cassorla* is an entirely text-based system. Under *Cassorla*, to highlight a portion of text, a user must identify two precise points to “bracket” the content to be highlighted. (Col. 4, lines 39-42). With *Cassorla*, a user cannot enter a freehand stroke. All entries are text-based entries with predefined characteristics. A user can choose a color or type style, but she cannot underline content so that the line is not straight, or passes through content on the display. Under Applicants’ system, as clearly shown in Figures 6 and 7, a user can input strokes that are not text-based, but graphics-based, i.e., based on pixel-blending.

There is no motivation to combine because it is not plausible to convert the rigid character-based system of *Cassorla* to a graphics-based document browser that permits freehand strokes to be inputted. Therefore, the motivation to combine *Cassorla* and Applicants’ written description is improper.

The Action relies on the same basis for rejection of Applicants' claim 1 to reject Applicants' claims 10 and 16. Applicants' claims 10 and 16 are patentably distinct over the improper motivation to combine *Cassorla* and Applicants' written description for substantially the same reasons as recited above in reference to Applicants' independent claim 1.

Applicants' claims 2-9, 11-15, and 17-20, which depend from claims 1, 10, and 16, respectively, are patentably distinct over the improper motivation to combine *Cassorla* and Applicants' written description for at least the same reasons as their ultimate base claim and further in view of the novel features recited therein.

For example, *Cassorla* fails to teach or suggest, "blending pixels from the currently displayed document with a translucent color to produce a translucent annotation," as recited, among other features, in Applicants' claim 4, and, "wherein the translucent annotation is generated by blending pixels from the currently displayed document with a highlighting pixel color," as recited, among other features, in Applicants' claim 18. The Action cites column 4, lines 4-43 of *Cassorla* as teaching these features. The cited portion describes placemarks, bookmarks, highlighting and margin flags. Indeed, the cited portion describes highlighting context and identifying a color or type style, but fails to describe anything as to pixel blending. Neither this portion, nor any other portion of *Cassorla*, either alone or in combination with Applicants' written description teach or suggest, "blending pixels from the currently displayed document with a translucent color to produce a translucent annotation," as recited, among other features, in Applicants' claim 4, and "wherein the translucent annotation is generated by blending pixels from the currently displayed document with a highlighting pixel color," as recited, among other features, in Applicants' claim 18.

In addition, *Cassorla* fails to teach or suggest, "storing a separate stroke for each annotation, wherein each stroke corresponds to a continuous set of movement when the user input device is activated," as recited, among other features, in Applicants' claim 7. The Action cites Figure 1 of *Cassorla* as describing this feature of Applicants' claim 7. Figure 1 of *Cassorla* shows a display 26 with an image of a formatted text stream 25' and images of annotation strings 24'. Images of annotation strings 24' are merely text-based keyboard 50 entered annotations that are associated with particular paragraphs, subparagraphs, etc. of the image of the formatted text

stream 25'. Even assuming a proper motivation to combine, neither this portion, nor any other portion of *Cassorla*, either alone or in combination with Applicants' written description, teach or suggest, "storing a separate stroke for each annotation, wherein each stroke corresponds to a continuous set of movement when the user input device is activated," as recited among other features, in Applicants' claim 7.

*Cassorla* is deficient also in regards to Applicants' claims 5 and 13. Applicants' claim 5 recites, among other features, "using an erase highlighting that erases previously annotated areas of the currently displayed document page." Applicants' claim 13 recites, among other features, "wherein the computer software displays and stores erased annotations that remove previously made annotations on the currently displayed document page." The Action cites Figure 1 of *Cassorla* as disclosing, "instructions for erasing portions of previously created annotations" to reject Applicants' claim 5. The Action cites Figure 3 of *Cassorla* as disclosing, "computer software [that] displays and stores erased annotations that remove previously made annotations on the currently displayed document page" to reject Applicants' claim 13. At best, *Cassorla* allows for the revision or deletion of previously created annotations 28. (Col. 9, lines 57-58). However, because the system in *Cassorla* is text-based, a user cannot use an erase highlighting to erase portions of a graphical entry such as the entry shown in Applicants' Figure 7. Clearly, the text-based system of *Cassorla* fails to teach or suggest these features of Applicants' claims 5 and 13.

#### **New Claims 21-29**

New claims 21-24 are fully supported by the specification and drawings. Even if the combination of *Cassorla* and Applicants' written description were proper, *Cassorla* fails to teach or suggest the features of Applicants' new claims 21-29.

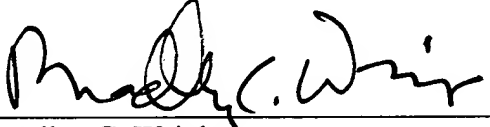
Appl. No. 09/455,805  
Amdt. Dated June 18, 2003  
Response to Office Action dated March 24, 2003

**CONCLUSION**

All rejections having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same. Should the Examiner find that a telephonic or personal interview would expedite passage to issue of the present application, the Examiner is encouraged to contact the undersigned attorney at the telephone number indicated below. No fee is believed due, however, if any fees are required or if an overpayment has been made the Commissioner is authorized to charge or credit Deposit Account No. 19-0733. Applicants look forward to passage to issue of the present application at the earliest convenience of the Office.

Respectfully submitted,  
**BANNER & WITCOFF, LTD.**

Date: June 18, 2003

By:   
Bradley C. Wright  
Registration No. 38,061

1001 G Street, N.W.  
Eleventh Floor  
Washington, D.C. 20001-4597  
(202) 824-3000